

I. **The Office Action**

The cover page of the office action mailed August 25, 2006 indicates that claims 1-22 are subject to restriction. The body of the office action states that:

2. Restriction is required under 35 USC 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-11, drawn to a structure for an optically effective diffraction security element.

Group II, claim(s) 12-22, drawn to an apparatus for examining documents provided with optically effective diffraction elements which is characterized by a capacitively operating scanner the width of which is larger than the largest width of a document.

The inventions listed as Groups 1-2 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Group II is drawn to an apparatus with its own specific technical features which are not relevant or necessary for the search and consideration of the structure of the object of Group I. For example, the object of Group I is able to be examined with another, separate apparatus. [Office action mailed August 25, 2006 page 2 lines 7-23.]

II. **Response with Provisional Election and Traverse**

In response, the applicant provisionally elects Group I, claims 1-11, with traverse. The applicant traverses because the restriction requirement does not comply with authority binding upon the examiner for the reasons noted below.

**III. The Examiner has not Met the Burden Required in PCT Rules 13.1 and 13.2 and MPEP 1850 to Show Lack of Unity of Invention**

PCT Rule 13.1 states that:

The international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept (“requirement of unity of invention”).

PCT Rule 13.2 states that:

Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

MPEP 1850 outlines the examiner’s standard for proving lack of unity of invention, stating in pertinent part, with emphasis supplied, that:

Although lack of unity of invention should certainly be raised in clear cases, it should neither be raised nor maintained on the basis of a narrow, literal or academic approach. There should be a broad, practical consideration of the degree of interdependence of the alternatives presented, in relation to the state of the art as revealed by the international search or, in accordance with PCT Article 33(6), by any additional document considered to be relevant. If the common matter of the independent claims is well known and the remaining subject matter of each claim differs from that of the others without there being any unifying novel

inventive concept common to all, then clearly there is lack of unity of invention.

**If, on the other hand, there is a single general inventive concept that appears novel and involves inventive step, then there is unity of invention and an objection of lack of unity does not arise.** For determining the action to be taken by the examiner between these two extremes, rigid rules cannot be given and each case should be considered on its merits, **the benefit of any doubt being given to the applicant.**

The applicant submits that the examiner has not presented the required “broad, practical consideration of the degree of interdependence of the alternatives presented, in relation to the state of the art as revealed by the international search or, in accordance with PCT Article 33(6), by any additional document considered to be relevant.” Moreover, the examiner’s conclusion is contradicted by the international search. Furthermore, the examiner’s conclusion is not supported by any additional document considered to be relevant, as required by MPEP 1850.

In addition, the examiner’s conclusions as to search burden are contradicted by the facts that claims 1-22 have already all been searched, and examined, both in the international stage and here in this national stage (by Examiner Lee in the prior office action). Moreover, the number of claims, only 22, presents no unusual burden.

PCT Rule 13.2 contains the standard for showing unity of invention, stating that:

... the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features.

On page 2 lines 18-23 of the office action mailed August 25, 2006, the examiner stated that:

The inventions listed as Groups 1-2 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack

the same or corresponding special technical features for the following reasons:  
Group II is drawn to an apparatus with its own specific technical features which are not relevant or necessary for the search and consideration of the structure of the object of Group I. For example, the object of Group I is able to be examined with another, separate apparatus.

The examiner's language merely mimics the rule without identifying any "special technical features". Accordingly, it is mere conclusion, which does not carry the examiner's burden. Therefore, the examiner has not proven a lack of unity of invention between Groups I and II.

Moreover, the MPEP states that in proving lack of unity of invention, the benefit of the doubt is given to the applicant. The examiner has not presented any evidence or cited any claim features to overcome this presumption.

There is no support for the requirement for restriction; therefore it should be withdrawn.

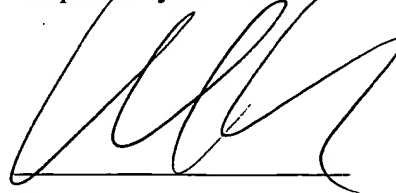
#### IV. Closure

Should Examiner Caputo have any questions, the examiner is urged to contact the undersigned at (703) 415-0012.



Date

Respectfully Submitted,



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March 13, 2006 (1:30pm)

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